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| 09/700,863      | 11/21/2000  | Philip Edwin Howse   | A0-1269             | 2839             |

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EXAMINER

GOLBA, TARA M

ART UNIT PAPER NUMBER

3644

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/700,863

Applicant(s)

HOWSE, PHILIP EDWIN

Examiner

Tara M. Golba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-26,28-46,48 and 50-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-26,28-46,48 and 50-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-57 have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

2. The abstract of the disclosure is objected to because of the following informality: In lines 3-4, the phrase "close to a bearing the particulate material" is unclear. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

3. Claims 6 and 28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 6 depends on claim 5, which has been cancelled, and claim 28 depends on claim 27, which has been cancelled.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23-26, 28-35, 42, and 44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by International Patent Publication WO 94/00980 to Howse.

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In reference to claim 23, Howse ('980) discloses a pest control apparatus including a surface in a region of which a pest is capable of being lured (page 12, lines 17-19) and which bears a particulate material incorporating a killing or behavior-modifying agent (page 12, lines 21-23; page 16, lines 24-29), the particulate material being capable of being electrostatically charged when rendered airborne by movement of the pest in the region of the surface (page 8, lines 14-20, where it is understood that particles that can be charged by friction would accordingly be charged by the friction they encounter while being rendered airborne). Note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

In reference to claim 24, Howse discloses a powder sufficiently fine to be rendered airborne by a pest moving across, flying above, or taking off from the surface, such that the pest becomes at least partially coated with the powder (page 5, lines 28-31; page 12, lines 20-25, where it is understood that fine particles can be rendered airborne).

In reference to claim 25, Howse discloses a powder combined with at least one biological, synthetic or natural pesticide as a killing agent (page 16, lines 24-25).

In reference to claim 26, Howse discloses an insect pest (page 1, lines 7-8).

In reference to claim 28, Howse discloses a particulate material chargeable by friction (page 8, lines 14-15).

In reference to claim 29, Howse discloses a surface associated with a trap comprising an electrically insulating material (page 10, lines 31-35, where the plastic is electrically insulating).

In reference to claim 30, Howse discloses a plastics material (page 10, lines 31-35).

In reference to claim 31, Howse discloses a pheromone or parapheromone attractant (claim 25).

In reference to claim 32, Howse discloses a surface coated with an electrostatically charged fine powder (claims 30, 33, and 46).

In reference to claim 33, Howse discloses a powder capable of retaining its electrostatic charge while on the trap surface (page 12, lines 21-23).

In reference to claims 34 and 35, Howse discloses an apparatus wherein undesired removal or loss of the particulate material is eliminated or reduced by raised edges at the periphery of the surface (figure 1A, where raised edge 7 prevents loss of particulate material).

In reference to claim 42, Howse discloses a tubular trap (figure 1A).

In reference to claim 44, Howse discloses a surface comprising an interior surface of the trap (figure 1B, surface 21).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-13, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howse publication WO 94/00980 in view of admitted prior art (referred to herein as "Admission").

In reference to claim 1, Howse discloses a method of coating a pest with a particulate material incorporating a killing or behavior-modifying agent, the method comprising the step of

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drawing a pest sufficiently close to a surface bearing the particulate material (page 12, lines 17-23). Howse discloses that this particulate material can become electrostatically charged by friction and by being dispensed into the air (page 8, lines 14-24), and it is therefore understood that the friction of movement in the air can charge the particles, but Howse does not specifically discuss that movement of a pest in the region of the surface renders the particulate material airborne.

Admission teaches that it is well known in the art that a flying insect provides downward momentum to the air around it and can generate vortices on the downward strokes of their wings (Specification, page 14, lines 10-18). This teaching therefore demonstrates that the movement of an insect's wings is naturally accompanied by movement of the air around the insect. Since Howse discloses that flying insects are drawn into the region of a fine particulate matter, and since Admission teaches that it is well-known that flying insects provide momentum to the air around them, it is considered inherent in the method disclosed by Howse that the fine particles in the Howse trap would be rendered airborne when a flying insect was drawn close to the surface with the particulate material. This is a naturally occurring phenomenon. As discussed above, Howse teaches that friction imparts a charge to the particles, and it is therefore understood that movement of the particles into the air would provide them with a charge.

In reference to claims 2-4, 6-13, 20, and 22, Howse ('980) discloses the claimed invention. See discussion of claims 24-26, 28-35, 42, and 44, respectively.

8. Claims 14-19, 21, 36-41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howse ('980) in view of U.S. Patent No. 5,685,109 to Rimback.

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In reference to claims 14-19 and 36-41, Howse does not disclose the claimed recess accommodating the particulate material.

Rimback discloses a recess (figures 3-4, element 66) defined in a surface on a plate which is preformed and stands alone (plate 62), the recess comprising a trough (cup 66) and being provided with raised edges (element 64), and the recess accommodating an insect bait material (column 3, lines 37-42). Rimback teaches that the recess allows one insect bait material to be kept separate from a liquid bait material, thereby allowing for the provision of multiple materials for baiting and trapping insects (column 3, lines 37-42). Therefore, it would have been obvious to one having ordinary skill in the art to accommodate the particulate material disclosed by Howse in a recess as taught by Rimback, so that multiple insect trapping or killing materials can be used throughout different regions of the apparatus. Rimback does not disclose that the recess is smaller than the pests being controlled, but it would have been obvious to design a recess smaller than the pests being controlled, since a change in size of a component is recognized as being within the level of ordinary skill in the art.

In reference to claims 21 and 43, Howse does not disclose a triangular trap.

Rimback teaches that a trap design including a triangular cross-section (figure 1) allows for inexpensive assembly from a single piece of plastic material (column 2, lines 4-5) and forms an enclosed volume for trapping and holding insects (column 1, lines 44-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a triangular shape, as taught by Rimback, for the trap disclosed by Howse, to facilitate assembly and to trap and hold insects.

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9. Claims 45, 46, 48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howse in view of Rimback.

In reference to claims 45, 46, 48, and 50, Howse, as modified in view of Rimback, discloses the claimed invention. See discussion of claims 23, 28, 32, 36, 37, and 41 above.

10. Claims 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howse in view of admitted prior art (Admission) and Rimback.

In reference to claims 51-56, Howse, as modified in view of Admission and Rimback, discloses the claimed method of preventing dispersion of a particulate material from a pest trap. See discussion of claims 1, 2, 10, and 12-14 above.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 23 and 44 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,041,543 to Howse since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.



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Note that it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Therefore, the patentable limitations of claims 23 and 44 are disclosed in claim 1 of patent ‘543 to Howse.

Likewise, claim 25 is rejected under the judicially created doctrine of double patenting over claims 1 and 11 of patent ‘543 to Howse, and claim 31 is rejected over claims 1 and 8-10 of patent ‘543 to Howse.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

13. Claims 1, 4, 6, 10, 11, and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,041,543 to Howse in view of Admission. See teachings of Admission as discussed in reference to claims 1, 4, 6, 10, 11, and 22 above.

14. Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21 and 22 of U.S. Patent No. 6,041,543 to Howse in view of Admission.

15. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12, 19, and 20 of U.S. Patent No. 6,041,543 to Howse in view of Admission.

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16. Claims 14-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,041,543 to Howse in view of Rimback. See teachings of Rimback as discussed in reference to claims 14-19 above.

17. Claims 24, 28-30, 32-35, and 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,041,543 to Howse in view of Howse WO 94/00980. See teachings of Howse ('980) above.

18. Claims 36-41, 43, 45, 46, and 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,041,543 to Howse in view of Rimback. See teachings of Rimback above.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,771,628 to Nobbs

U.S. Patent No. 4,553,698 to Parker et al.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara M. Golba whose telephone number is (703) 305-0266. The examiner can normally be reached on Monday-Thursday from 8:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan can be reached at (703) 306-4159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

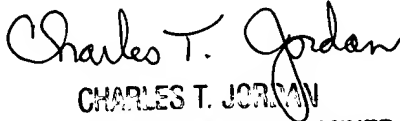
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

tmg  
February 23, 2003

  
CHARLES T. JORDAN  
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